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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

NGUYEN, N

ART UNIT

PAPER NUMBER

2754

DATE MAILED:

03/16/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/865,403

Applicant(s)

Asano

Examiner  
Nga B. Nguyen

Group Art Unit  
2764



☒ Responsive to communication(s) filed on Jan 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. This Office Action is in response to the Amendment filed on January 4, 2000, which paper has been placed of record in the file.
2. Claims 1-16 are pending in this application.

#### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-3, 7-11, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Sirbu et al, U.S. Patent No. 5,809,144.

Regarding claim 1, Sirbu discloses a charging system for electronic commerce, which comprises a service provider terminal for providing service to a user via a network in response to

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a request from a user terminal, the system charging a user a fee corresponding to service, comprising:

a charge collection terminal for collection a fee from user, which fee is reflected by service provided by service provider terminal (figure 3, item 16 and column 6, lines 20-37), the charge collection terminal existing individually from said service provider terminal (figure 1, item 16),

wherein user terminal generates service request data and digital signature data and transmits them via the network to service provider terminal, and the service request data is for requesting desired service for the user from service provider terminal and the digital signature data is created based on service request data (figure 8 and column 9, lines 55-67).

Regarding claim 2, Sirbu discloses the charging system for electronic commerce , wherein: service provider terminal transmits to charge collection terminal digital signature data, service request data and charged fee data, the charged fee data calculated based on service request data (figure 9 and column 10, lines 19-49).

Regarding claim 3, Sirbu discloses digital signature data is created only by user (figure 8 and column 9, lines 55-58).

Regarding claim 7, Sirbu discloses the charging system for electronic commerce, wherein: service provider terminal charges a fee to user based on a time period service is provided to the user (column 3, lines 60-62).

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Regarding claim 8, Sirbu discloses the charging system for electronic commerce , wherein: service provider terminal charges a fee to user based on contents provided to the user (column 3, lines 60-62).

Claims 9-11 and 15-16 are written in function method and contain the same limitations as claims 1-3 and 7-8, respectively, therefore are rejected by the same rationale.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu et al, U.S. Patent No. 5,809,144 in view of Elgamal, U.S. Patent No. 5,671,279.

Regarding claim 4, Sirbu discloses: user terminal comprised memory medium which stores service request data (figure 1, item 10). However, Sirbu does not disclose: when the user objects to the charge, in response to a fee collection notice from charge collection terminal, the user enables a sending of data stored in memory medium to charge collection terminal, and the charge collection terminal enables the read out service request data and digital signature data from memory medium to confirm the provided desired service. Elgamal discloses: when the user objects to the charge, in response to a fee collection notice from charge collection terminal, the

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user enables a sending of data stored in memory medium to charge collection terminal, and the charge collection terminal enables the read out service request data and digital signature data from memory medium to confirm the provided desired service (column 14, lines 35-40). It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine Sirbu's system with the step of sending data stored in memory medium as in Elgamal in order to improve the system of Sirbu. Yes, when service provider charges a user a more amount than an amount to charge properly, user can submit request data and digital signature data stored in memory medium to the bank for correcting it.

Regarding claim 5, Sirbu discloses digital signature data is created only by user (figure 8 and column 9, lines 55-58).

Claims 12-13 are written in function method and contain the same limitations as claims 4-5, respectively, therefore are rejected by the same rationale.

8. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu et al, U.S. Patent No. 5,809,144 in view of Elgamal, U.S. Patent No. 5,671,279, and further in view of Mizutani et al, U.S. Patent No. 4,823,388.

Regarding claim 6, Sirbu discloses user terminal is controlled by the user (figure 1, item 10 and column 4, lines 35-67). However, Sirbu does not teach service request data stored once in memory medium is impossible for the user to rewrite. Mizutani discloses service request data stored once in memory medium is impossible for the user to rewrite (column 2, lines 8-20). It would have been obvious to one with ordinary skill in the art at the time the invention was made

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to combine Sirbu's system with memory medium as in Mizutani because it would improve the system of Sirbu by allowing the user can store service request data once in memory medium and make it cannot be rewritten in order to ensure the security.

Claim 14 is written in function method and contains the same limitations as claim 6, therefore is rejected by the same rationale.

### ***Conclusion***

9. Claims **1-16** are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Friday from 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

11. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**or:**

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(703) 308-5357 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,

2121 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-3900.

Nga B. Nguyen  
March 6, 2000



MELANIE A. KEMPER  
PRIMARY EXAMINER